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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,351	10/21/2003	Seth A. Foerster	OP-11-1	4188
21394 7590 12/12/2008 ARTHROCARE CORPORATION 7500 Rialto Boulevard Building Two, Suite 100 Austin, TX 78735-8532				
EXAMINER NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
NOTIFICATION DATE		DELIVERY MODE		
12/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocure.com

# Office Action Summary

## Application No.

10/690,351

## Applicant(s)

FOERSTER ET AL.

## Examiner

Victor X. Nguyen

## Art Unit

3734

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 7/22/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. In response to applicant's remarks of 7/22/2008, the examiner has removed all prior 35 U.S.C. 112- first and Drawings objection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9,11-12 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kearns et al (6,156,056).

Kearns et al disclose in figures 23-25 and abstract, a device for attaching connective tissue to bone, including: a body 402 has a first configuration and second configuration, where the body includes a plurality of spaced slits 418, where each of the slits has a length, and where a distance x occurs at 418 which is smaller than a distance y occurs at 428. Kearns is silent that the second configuration characterized by a portion of the outer peripheral wall being radially enlarged relative to the longitudinal axis such that the apparatus has larger cross section in the second configuration than in the first configuration at the portion.

. Instead, Kearns indicates that the device has a first configuration in fig. 24 and a second configuration in figure 25, where the arrangement of slits 418 and 428 would promote some sort of radial expansion at the longitudinal axis.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to modify Kearns' device with the second configuration can be radially enlarged such that the apparatus has a larger cross section in the second configuration than in the first configuration at the point because Applicant has not disclosed that the second configuration can be radially enlarged such that the apparatus has a larger cross section in the second configuration than in the first configuration at the point provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kearns' device, and applicant's invention, to perform equally well with either the device taught by Kearns because both device would perform the same function of providing a hollow tube has a plurality of slits to attach soft tissue to bone. Therefore, it would have been obvious to modify Kearns to obtain the invention as specified in the above claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kearns. Where each of the slits can comprise an angled surface at an end thereof (see fig. 23 at element 418), where the plurality of spaced slits 418 has an acute angle which is between 0 and 45 degrees (see col. 4, lines 20-25), and where the plurality of spaced slits comprises at least six slits (fig. 23), and where the device further comprises a suture retaining feature (100 or 400, see col. 3, lines 65-67 and col. 4, lines 1-5). As to claims 4-25, Kearns discloses in figures 1, 23-25, abstract and col. 3, lines 50-62 an apparatus for attaching tissue to bone having the limitations as described above.

#### **Allowable Subject Matter**

3. Claim 26 is allowed over the art of record.

The following is a statement of reasons for allowance: None of the prior art of record, alone or in combination, discloses or suggests where a body includes a plurality of spaced slits disposed about the outer peripheral wall, *each of the slit extends axially and defining ribs therebetween, each of the ribs comprises a fixed proximal end, an intermediate section and a fixed distal end*, and the apparatus further comprises a laterally disposed suture hole for receiving a suture.

***Response to Arguments***

4. Applicant's arguments filed 7/22/2008 have been fully considered but they are not persuasive. Applicant states that Kearns does not disclose a device where the second configuration characterized by a portion of the outer peripheral wall being radially enlarged relative to the longitudinal axis such that the apparatus has larger cross section in the second configuration than in the first configuration at the portion. Examiner disagrees. First, Applicant has not disclosed that the second configuration characterized by a portion of the outer peripheral wall being radially enlarged relative to the longitudinal axis such that the apparatus has larger cross section in the second configuration than in the first configuration at the portion provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kearns' device, and applicant's invention, to perform equally well with either the device taught by Kearns because both device would perform the same function of providing a hollow tube has a plurality of slits to attach soft tissue to bone. Therefore, it would have been obvious to modify Kearns to obtain the invention as specified in the above claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kearns. In fact, the

device in Kearn does exhibit some sore of radial expansion relative to the longitudinal axis of the device, as the distance between the longitudinal axis and the outer radius are varied as the device is manipulated in a bent configuration (see fig. 25). Applicant further states that Kearns fails to disclose slits in an outer peripheral wall of a body that are longitudinal disposed. Examiner disagrees. As seen in fig. 25, when viewed from a bird's eye point of view, the slits 418 resembled as in inverted V-shaped are longitudinal disposed about the outer peripheral wall.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN